

REMARKS

The office action of October 18, 2005 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1-18 remain in this case. Claims 1, 5, 10, 11 and 15 are independent, all of them are hereby amended herein.

I. REJECTION(S) UNDER 35 U.S.C. §103(a)

Claims 1-3, 5-11 and 13-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,327,599 to Warmus et al. (hereafter merely Warmus) in view of Barnes, 10 Minute Guide To Windows 3.1 (Sams 1992) p. 119-123. (hereafter merely Barnes).

Claim 1 recites:

“A document formatting tool comprising:
means for initially providing data constituting a document that is meaningful to a layperson as a final printable document;
means for intercepting said data in said document when said data is being sent to a printer from a print spool associated with said printer;
means for utilizing a specified portion of such intercepted data as an index key to access a database for obtaining other information relevant to such data; and
means for printing such data in a format different from that in which it was received from said print spool, such difference being based upon said other information received from the database” (*emphasis added*).

The instant October 18, 2005 Office Action states, *inter alia*:

“Moreover, the applicant submits that Warmus does not support the teaching of intercepting the print job after it has been sent to the printer (pages 7-8). The Examiner disagrees because Warmus discloses the inserting of variable data from a database into a document during the printing—after print command has been issued (col. 8, lines 54-57).”

The relevant citation (i.e., col. 8, lines 54-57) of the above are listed below for the benefit of the Examiner.

“The files 130, 132 are then converted into variable page files 134, 136. The files 134, 136 are identical to the files 130, 132, respectively, except that the data in each file identifying entries in the database are replaced by the actual data stored at such entries”. (*emphasis added*).

As can be seen, the identifying entries are different or NOT the same as the actual data stored at such entries in the database. The identifying entries are meaningless to a layperson when printed since they may be any kind of symbol denoting a variable. It is only when the actual data stored at such entries replace the identifying entries, then the resultant data become meaningful to a layperson when printed. Therefore, the “the inserting of variable data from a database into a document during the printing—after print command has been issued” in Warmus is not read on the “means for intercepting said data in said document when said data is being sent to a printer from a print spool associated with said printer” as claimed in claim 1.

Furthermore, in prior Office Actions, the Examiner admitted that Warmus failed to explicitly disclose a print spool associated with the printer. The Examiner then used the combination of Warmus and Barnes in the obviousness rejection of claim 1.

This bags the question as to where the spool or a device with the queue in Barnes is placed or positioned in the combination of Warmus and Barnes. Since all the Office Actions relating to this subject matter does NOT give Applicant a clear showing, Applicant attempts several exemplified combinations of Warmus and Barnes.

In all the exemplified combinations, Applicant has concluded that the combination of Warmus and Barnes does not teach or suggest the present invention. The exemplified combinations are the four examples listed infra using Fig. 5 of Warmus.

EXAMPLE 1

Spool positioned at point 1 is meaningless in that no means for intercepting said data in

said document when said data is being sent to a printer from a print spool associated with said printer and means for utilizing a specified portion of such intercepted data as an index key to access a database for obtaining other information relevant to such data is involved therein.

Therefore, placing the spool at point 1 does NOT yield the teachings of claim 1.

EXAMPLE 2

If the spool is positioned at point 2, no data, only commands are involved therein. Therefore, placing the spool at point 2 does NOT yield the teachings of claim 1.

EXAMPLE 3

If the spool is positioned at point 3, only variables or file identifying entries are here in that actual data are not read from variable information database 108. In other words, no means for initially providing data constituting a document that is meaningful to a layperson as a final printable document is involved herein. As clearly stated in col. 8, lines 54-57 of Warmus, the variable page files 134, 136 are identical to the files 130, 132, respectively, except that the data in each file identifying entries in the database are replaced by the actual data stored at such entries.

Therefore, placing the spool at point 3 does NOT yield the teachings of claim 1.

EXAMPLE 4

If the spool is positioned at point 4, the interaction with database 108 has already been achieved even in Warmus. In other words, no means for intercepting the data in the document when the data is being sent to a printer from a print spool associated with the printer, and means for utilizing a specified portion of such intercepted data as an index key to access a database for

obtaining other information relevant to such data are involved.

Therefore, placing the spool at point 4 does NOT yield the teachings of claim 1.

It is noted that FIG. 5, which is a generalized diagram of Warmus, is used in the following examples. For the benefit of the Examiner, Applicant has attached a marked up copy of Fig. 5 (i.e., Exhibit A) with numerals in red identifying the points of discussion, wherein the Barnes “spool” may be positioned.

The above examples are used for the purpose of clarifying matters because in the two prior responses to the Examiner’s Office Actions, Applicant was trying to deductively prove that the combination of Warmus and Barnes does not read on claim 1. Since the Examiner find the deductive method unpersuasive, an inductive method is used this time.

If the Examiner still disagrees with the above portraying of the combination of Warmus and Barnes, Applicant respectfully invites the Examiner to point out exactly where a print spool associated with the printer is positioned in Warmus thereby making the combination of Warmus and Barnes read on claim 1. Applicant respectfully reminds the Examiner that in a 103 rejection, references are not properly combinable or modifiable if their intended function is destroyed.

In addition, the Examiner seems to equate identifying entries of Barnes with the specified portion of such intercepted data of the present invention. This is not the case because identifying entries are NOT meaningful to a layperson, whereas the specified portion of such intercepted data are.

Therefore, the combination of Warmus and Barnes does not teach or suggest the means for initially providing data constituting a document that is meaningful to a layperson as a final printable document, means for intercepting the data in the document when the data is being sent to

a printer from a print spool associated with the printer, and means for utilizing a specified portion of such intercepted data as an index key to access a database for obtaining other information relevant to such data, all as claimed in claim 1.

Therefore claim 1 is deemed patentable. For similar reasons, independent claims 5, 10, 11 and 15 are also deemed patentable.

In addition, claim 15 recites additional features, which are not taught or suggested by the combination of Warmus and Barnes.

II. DEPENDENT CLAIMS

The other claims are dependent upon their respective independent claims. By virtue of their dependency, as well as additional languages that they respectively contain, are deemed patentable.

CONCLUSION

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

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Respectfully submitted,

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